REMARKS

1. Summary of Rejections in the Office Action of August 13, 2004

At page 2, paragraph 3 of the Office Action, the Examiner rejects claims 1-19 under 35 U.S.C. § 112, ¶1, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the claimed invention. At page 3, paragraph 7 of the Office Action, the Examiner rejects claims 1, 2, 5, 6, 13, 14, and 16-19 under 35 U.S.C. § 103(a), as allegedly being obvious in view of U.S. Patent No. 6,237,039 to Ubowski and U.S. Patent No. 6,237,039 B1 to Perlman. At page 8, paragraph 15 of the Office Action, the Examiner rejects claim 3 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Ubowski, Perlman, and U.S. Patent No. 6,237,039 to Young. At page 9, paragraph 17 of the Office Action, the Examiner rejects claims 4 and 15 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Ubowski, Perlman, and U.S. Patent No. 6,061,733 to Bodin *et al.* ("Bodin").

2. 35 U.S.C. § 112, ¶1 Rejections

At page 2, paragraph 3 of the Office Action, the Examiner rejects claims 1-19 under 35 U.S.C. § 112, ¶1, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the claimed invention.

The Applicants respectfully TRAVERSE the Examiner's enablement rejections and assert the following remarks in response:

The Applicants' independent claims 1 and 7 each describe a system comprising "a software delegate . . . configured to control an amount of said data and a size of said at least one portion of said network object to be downloaded from said server facility to said client independent of a user of said client and based solely upon an operating state of said client." The Applicants' independent claim 13 describes a method comprising the step of "controlling a size of said portions of said network object received from said server facility independent of a user of said client computer and based solely upon an operating state of said client computer."

The Examiner asserts that "the specification does not teach a software delegate configured to control an amount of said data and a size of said at least one portion of said network object . . . based solely upon an operating state of said client." Office Action, Page 2 Paragraph 4. The Examiner also asserts that "[i]nstead, the specification teaches a system that will download portions while the client is in an idle state and suspend downloading while the client is busy." Id. "The size of the downloaded portion is not controlled; it is passively determined based on the activity of the client." Id. "Based on the teaching of the specification, any system that can download a portion of a file while in an idle state and then resume downloading at a later time based on the operating state would be analogous to the current claims." Id. The Applicants respectfully disagree.

In the Applicants' claimed invention as set forth in independent claims 1, 7, and 13, the software delegate controls the amount of the data

downloaded and the size of the at least one portion of the network object downloaded based solely on the operating state of the client by initiating the download while the client is in the idle state, and concluding (temporarily if the download is not fully completed) the download when the client transitions from the idle state to the busy state. However, if as asserted by the Examiner the software delegate did not either control (directly or indirectly) the amount of the data downloaded and the size of the at least one portion of the network object downloaded, then once the download began, **the download would continue until the <u>entire</u> download was complete regardless/independent of the state of the client**.

The Examiner asserts the size of the downloaded portion is not in any way controlled, and instead, the size of the downloaded portion is passively determined based on the activity of the client. The Applicants note that **the size of the downloaded portion must be controlled by <u>some</u> physical element** (either directly or indirectly) because if no physical element controls the size of the downloaded portion, then the download will continue until the download is complete **regardless/independent of the state of the client**. The Applicants also note that the state of the client cannot control the size of the downloaded portion, and instead, information associated with the state of the client merely can be used by the controlling element to determine whether to start/continue the download or whether to conclude/prevent the download. Moreover, while the Applicants agree that the size of the downloaded portion passively is determined by the activity of the client, independent claims 1, 7, and 13 **do <u>not</u> state that**

the software delegate _determines_ the size of the downloaded portion. Instead, the software delegate merely determines the state of the client, e.g., idle or busy, and controls whether or not a download is to occur during a particular time based on such state of the client. Because the software delegate controls whether or not the download is to occur during the particular time based on the state of the client during the particular time, the software delegate controls (directly or indirectly) the size of the downloaded portion (based on the state of the client). Therefore, the Applicants respectfully request that the Examiner withdraw the enablement rejection of claims 1-19.

3.   35 U.S.C. § 103(a) Rejections

At page 3, paragraph 7 of the Office Action, the Examiner rejects claims 1, 2, 5, 6, 13, 14, and 16-19 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Ubowski and Perlman. At page 8, paragraph 15 of the Office Action, the Examiner rejects claim 3 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Ubowski, Perlman, and Young. At page 9, paragraph 17 of the Office Action, the Examiner rejects claims 4 and 15 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Ubowski, Perlman, and Bodin.

The Applicants respectfully TRAVERSE the Examiner's obviousness rejections and assert the following remarks in response:

In order for the Examiner to establish a _prima facie_ case for obviousness, three (3) criteria must be met. First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143. Moreover, "[i]t is improper to combine references where the **teach away from their combination**." MPEP 2145 (Emphasis added.) The Applicants maintain that the Examiner fails to establish a prima facie case for obviousness because Ubowski teaches away from its modification to include those claimed limitations of claims 1 and 7, which are missing from Ubowski

a. Independent Claim 1

The Applicants' independent claim 1 describes a system comprising "a software delegate . . . configured to control an amount of said data and a size of said at least one portion of said network object to be downloaded from said server facility to said client **independent of a user of said client** and based solely upon an operating state of said client." (Emphasis added.) At page 4, paragraph 8, of the Office Action, the Examiner acknowledges that Ubowski does not disclose or suggest that the at least one portion of the network object may be downloaded independent of a user of the client and based solely upon the operating state of the client. However, at page 4, paragraph 8 of the Office Action, the Examiner alleges that Perlman discloses or suggests these

elements missing from Ubowski, and that it would have been obvious to those of ordinary skill in the art at the time of the invention to modify Ubowski to include these missing elements. For the reasons set forth below, the Applicants maintain that Ubowski teaches away from the Examiner's proposed modifications to Ubowski.

For example, Ubowski describes a system in which a file is divided into a plurality of subfiles, and the user can select which of the subfiles the user wishes to download. Specifically, Ubowski states that "[t]he present invention therefore introduces the broad concept of allowing a client to download only **selected portions** of a file, instead of **the entire file**." Ubowski, Column 4, Lines 10-12. "This alleviates needless network traffic that results when **undesired portions** of files are downloaded." *Id.* at Lines 12-14. Thus, Ubowski teaches dividing the file into subfiles so that the user of the client can download only those portions of the file which are of interest to the user of the client. However, in order for the system described in Ubowski to perform its desired function of allowing the user of the client to select only those portions of the file which are of interest to them, the system described in Ubowski **cannot download the file independent of the user of the client because the user of the client is the only one that can decide which portions of the file are of interest to them**. As such, Ubowski teaches away from the modification proposed by the Examiner. Therefore, the Applicants respectfully request that the Examiner withdraw the obviousness rejection of claim 1, and allow the same to issue in a U.S. patent.

b.   **Independent Claim 13**

The Applicants' independent claim 13 describes a method comprising the step of "controlling a size of said portions of said network object received from said server facility **independent of a user of said client computer** and based solely upon an operating state of said client computer." (Emphasis added.) At page 4, paragraph 8, of the Office Action, the Examiner acknowledges that Ubowski does not disclose or suggest that the at least one portion of the network object may be downloaded independent of a user of the client and based solely upon the operating state of the client. However, at page 4, paragraph 8 of the Office Action, the Examiner alleges that Perlman discloses or suggests these elements missing from Ubowski, and that it would have been obvious to those of ordinary skill in the art at the time of the invention to modify Ubowski to include these missing elements. For the reasons set forth below, the Applicants maintain that Ubowski teaches away from the Examiner's proposed modifications to Ubowski.

For example, Ubowski describes a system in which a file is divided into a plurality of subfiles, and the user can select which of the subfiles the user wishes to download. Specifically, Ubowski states that "[t]he present invention therefore introduces the broad concept of allowing a client to download only **selected portions** of a file, instead of **the entire file**." Ubowski, Column 4, Lines 10-12. "This alleviates needless network traffic that results when **undesired portions** of files are downloaded." *Id.* at Lines 12-14. Thus, Ubowski teaches

dividing the file into subfiles so that the user of the client can download only those portions of the file which are of interest to the user of the client. However, in order for the system described in Ubowski to perform its desired function of allowing the user of the client to select only those portions of the file which are of interest to them, the system described in Ubowski **cannot download the file independent of the user of the client because the user of the client is the only one that can decide which portions of the file are of interest to them**. As such, Ubowski teaches away from the modification proposed by the Examiner. Therefore, the Applicants respectfully request that the Examiner withdraw the obviousness rejection of claim 13, and allow the same to issue in a U.S. patent.

c.   Dependent Claims 2-6 and 14-19

Claims 2-6 and 14-19 depend from independent claims 1 and 13, respectively. "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious." MPEP 2143.03 (citations omitted). Therefore, the Applicants respectfully request that the Examiner also withdraw the obviousness rejections of claims 2-6 and 14-19, and allow the same to issue in a U.S. patent.

CONCLUSION

The Applicants respectfully submit that the above-titled patent application is in condition for allowance, and such action is earnestly requested. If the Examiner believes that an in-person or telephonic interview with the Applicants' representatives will in any way expedite the examination of the above-titled patent application, the Examiner is invited to contact the undersigned attorney of record. The Applicants believe that no fees are due as a result of this response. However, in the event of any variance between the fees determined the Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

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